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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,761	07/16/2003	Glen Ward	359/002/PA	1712

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VENTANA MEDICAL SYSTEMS, INC.
ATTENTION: LEGAL DEPARTMENT
1910 INNOVATION PARK DRIVE
TUCSON, AZ 85755

EXAMINER

HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/621,761

Applicant(s)

WARD ET AL.

Examiner

Dwayne K. Handy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 3, 5, 12, 18, 22 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 12, 18, 22 and 27 recite the terms inboard and/or outboard. These terms are unclear. For example, claims 22 recites a retaining post mounted on the inboard aspect of the tray, and a support post mounted on the outboard aspect of the tray. It is unclear to the Examiner as to where the recited structures are located based on the terms outboard and inboard. In addition the terms as used in claim 22 lack antecedent basis. Claim 5 recites the limitation of the "downwards pitch of the slide from interior to exterior of the tray is...". This is also unclear. It appears to the Examiner that all slides are held in the tray. Therefore it is unclear which direction the downward pitch must run to meet the limitation of "from interior to exterior" of the tray. Claim 2 recites inner and outer slide frame supports. This is unclear. It appears that all of the frame supports are inside the tray. Claim 3 recites the means for locating comprising magnets. This is unclear. Applicant has already claimed a means for locating and positioning slide frame. Claim 2 limits this element. Claim 3 now recites another means for locating as well. The Examiner surmises that the magnet element is a different element than the means for

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locating and positioning the slide frame, but the claim as written does not clearly reflect that they are different elements.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8-11, 14, 15 19-21, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizusawa et al. (5,338,358).

5. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Chu (5,958,341). Chu teaches a tray and slide frame combination comprised of a slideholder (1) having slots for holding the slides and a tray (14). The Examiner considers the well boundary elements to be “posts” that support the slide.

Inventorship

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizusawa et al. (5,338,358) in view of Richards et al. (6,296,809). Mizusawa teaches every element of claims 13 and 23 except for a support shoulder on the retaining post. Richards teaches a thermal platform for holding a slide. The platform is best shown in Figure 8. The platform includes 4 posts having cutouts for holding the

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slide. It would have been obvious to one of ordinary skill in the art to combine the post cutouts from Richards with the posts of Mizusawa. One would add the cutouts to secure the slide and prevent movement of the slide.

9. Claims 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizusawa et al. (5,338,358) in view of Tseung et al. (5,439,649). Mizusawa teaches every element of claims 13 and 23 except for the slide tray having a sloped bottom. Tseung teaches a staining tray. The device is best shown in Figure 11B. As shown in the Figure and disclosed in column 13, lines 1-13, Tseung teaches a slide tray or holder (190) that rests on a drain tray (205). The bottom of the drain tray is sloped in order to enhance the collection of excess fluids used on the slide in the tray. It would have been obvious to one of ordinary skill in the art to combine the sloped bottom tray with the device of Mizusawa. One would add a sloped bottom to assist in the collection of fluids.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chu (5,958,341) in view of Richards et al. (6,296,809). Chu teaches every element of claims 13 and 23 except for a support shoulder on the retaining post. Richards teaches a thermal platform for holding a slide. The platform is best shown in Figure 8. The platform includes 4 posts having cutouts for holding the slide. It would have been obvious to one of ordinary skill in the art to combine the post cutouts from Richards with the posts of Chu. One would add the cutouts to secure the slide and prevent movement

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of the slide.

11. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu (5,958,341) in view of Pham et al. (6,426,050). Chu teaches every element of claims 6 and 7 except for the lid and handle. Pham teaches a multiwell plate having an ornamental caddy and lid. The lid covers the contents of the plate and the caddy provides surfaces for use in automated systems. It would have been obvious to one of ordinary skill in the art to add the caddy features and lid to the device of Chu. One would add these features in order to close and automatically transport the tray.

Conclusion


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH
April 2, 2007


Jill Warden
Supervisory Patent Examiner
Technology Center 1700